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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/514,663	08/14/95	EASLEY	

HARRIS, S
EXAMINER

3301/0309

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ART UNIT	PAPER NUMBER
3301	3

DATE MAILED: 09/29/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made fina

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Notice of Draftsman's Patent Drawing Review, PTO-948
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474..
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-3, 7-9, 13 and 14 are pending in the applicatior

Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 4-6, 10-12 and 15-19 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-3, 7-9, 13 and 14 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Claims 1-3 and 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,441,496. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the invention is not different by merely using broader claim language thus the claimed device is not patentably distinct from 5,441,496.

Claims 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 5,441,496 in view of Tano et al.

Tano et al disclose an ophthalmic laser apparatus having a curved distal end as claimed (see Fig. 5d) for varying divergence angle of laser irradiation.

It would have been obvious to one having ordinary skill in the art to have provided the device of Patent No. 5,441,496 with a curved distal end as shown by Tano et al for varying the exiting angle of laser irradiation.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hessel et al is cited as disclosing a laser device having a

curved distal end as claimed.

Any inquiry concerning this communication should be directed to Sonya Harris-Ogugua at telephone number (703) 308-2216.

Angela D. Sykes

Sonya Harris-Ogugua

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February 27, 1996
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